

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN ITALIAN PASTA
COMPANY,

Applicant

v.

BARILLA G. E R. FRATELLI- SOCIETA
PER AZIONI,

Applicant.

Opposition No. 91-161,373

78136703

APPLICANT'S MOTION FOR A UNILATERAL EXTENSION
OF DISCOVERY DEADLINE

Applicant hereby respectfully requests that the Board extend the discovery period for forty-five days solely for Applicant's benefit. As grounds for this motion, Applicant states the following material facts:

1. On September 9, 2004, one month after the opening of discovery, Applicant served its First Set of Interrogatories, Requests for Admissions and First Requests for Production of Documents on Opposer. See **Exhibit A**.
2. On February 22, 2005, Applicant served its Second Set of Interrogatories, Requests for Admissions, and Requests for Production of Documents on Opposer. See **Exhibit B**.
3. On April 1, 2005, fully six months after service of Applicant's first set of discovery requests, Opposer served its responsive documents on Applicant. These documents allegedly responded to both Applicant's First and Second Set of Production Requests. See **Exhibit C**.



06-07-2005

4. The parties agreed to extend the closure of the discovery period such that the discovery period would close on June 7, 2005. See **Exhibit D**.

5. On June 7, 2005, the last day of discovery, Applicant received a cd-rom containing a total of *over four hundred pages of additional documents* from Opposer. Opposer sent these to Applicant noting only that Opposer was supplementing Opposer's responses to prior Applicant's discovery requests. See **Exhibit E**.

ARGUMENT

By delaying serving a vast bulk of its documents on Applicant until the last days of discovery, Opposer has prejudiced Applicant. Specifically, Opposer has deprived Applicant of its right to take follow-up discovery.

Early in the case, indeed one month after discovery opened, Applicant timely served its First Set of Requests for Production of Documents on Opposer. Subsequently Applicant served its Second Set of Requests for Production of Documents on Opposer. Applicant cooperated with Opposer by giving Opposer approximately six months to produce its responsive documents. The parties thereafter extended the close of discovery such that Applicant would have sufficient time, given normal mailing procedures, after receiving Opposer's discovery documents on disk to have them reproduced in hard copy form, analyze them, consult with Applicant and to take follow-up discovery. Despite this cooperation, on the last date of discovery, Opposer served on Applicant *over four hundred pages of additional documents*. Because Opposer has delayed in serving its documents, Applicant lacks the opportunity to fully download Opposer's documents from disk to

hard copy, let alone to analyze them and to institute further inquiries before the discovery period closes.

Under well-established Board precedent, a party may not, by delaying its responses to discovery, deprive its adversary of its right to take follow up discovery. *See TBMP Section 403.04*. Where as here, a party delays serving its responses to discovery, the Board consistently has extended the discovery period solely for the propounding party's benefit. *Id. and see cases cited there*. To discourage a party from being rewarded for its discovery delays, the Board *does not* extend discovery for both parties. *Id.*

Based on this precedent, Applicant respectfully submits that the Board must extend discovery solely for Applicant's benefit. If the discovery period is not extended, Applicant will be prejudiced by its inability to take follow up-discovery. For example, Applicant cannot ask questions of Opposer regarding the new documents. Nor can Applicant potentially even use the documents in the case, as Opposer's actions have deprived Applicant of the ability to review the documents before serving Requests for Admissions on the documents to establish their authenticity for trial. Opposer should not be allowed to ambush Applicant with numerous documents at the end of the discovery period. Nor should Opposer be rewarded for its behavior by allowing it to obtain a further extension of its own period for discovery due to its dilatory behavior.

This is not the first time that Opposer has surprised Applicant with material changes in the case at the latest date. On May 6, 2005 the last time the discovery period was ending, Opposer served a Motion to Amend on Applicant with additional discovery, arguing for the first

time that Applicant lacks a bona fide intent to use. To ensure that Applicant would be prejudiced by these tactics, Opposer also argued that Applicant should not even be allowed to take discovery on the newly pleaded issue!

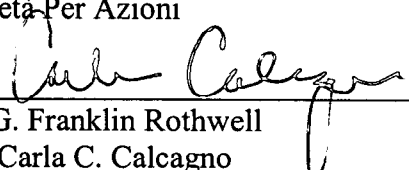
Applicant objected to that motion and has argued under well established Board precedent that if the Motion to Amend is granted the Board should extend discovery solely for Applicant on the newly pleaded ground.

In light of Opposer's actions today, the Board should extend the discovery period for forty-five days from its order on both pleaded grounds for opposition to allow Applicant time to analyze the new documents and to initiate further inquiries thereon.

Wherefore, Applicant respectfully requests that discovery be extended solely for Applicant's benefit for forty-five days, running from the date of the Board's decision on this motion, *solely for Applicant's benefit to take discovery on all grounds for opposition*, and that the opening of Opposer's testimony period be stayed and rescheduled accordingly.

Respectfully submitted,
Barilla G. E R. Fratelli -
Società Per Azioni

By


G. Franklin Rothwell

Carla C. Calcagno

Attorneys for Applicant

ROTHWELL, FIGG, ERNST & MANBECK

1425 K Street, N.W., Suite 800

Washington, D.C. 20005


Telephone: (202) 783-6040

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S MOTION FOR A UNILATERAL EXTENSION OF DISCOVERY DEADLINE was served via first-class mail, in a postage prepaid envelope, on counsel for Opposer as follows:

**Thomas H. Van Hoozer, Esq.
Law Offices of Hovey Williams LLP
2405 Grand Boulevard
Suite 400
Kansas City, Mo. 64108-2519**

This 7th day of June, 2005.



Joan Adair

EXHIBIT
A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA)	
COMPANY,)	
)	
Opposer)	
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v.)	Opposition No. 91-161,373
)	
BARILLA G. E R. FRATELLI - SOCIETA)	
PER AZIONI,)	
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Applicant.)	

APPLICANT'S FIRST SET OF INTERROGATORIES

Pursuant to Rules 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests that Opposer, American Italian Pasta Company ("AIPC"), serve upon Applicant sworn answers to the interrogatories set forth below at the offices of Rothwell, Figg, Ernst & Manbeck, 1425 K Street, N.W., Suite 800, Washington, D.C. 20005, within thirty (30) days after the service hereof. These discovery requests are intended to be continuing in nature and any information or related materials which may be discovered subsequent to the service and filing of the answers should be brought to the attention of the Applicant through supplemental answers within a reasonable time following such discovery.

For the convenience of the Board and the parties, Applicant requests that each discovery request (including subparts) be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

- a. The word "person" or "entity" shall mean and include without limitation, individuals, firms, associations, partnerships, and corporations.
- b. The term "Opposer", "AIPC," "you" or "your" shall mean American Italian Pasta Company, its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of the term, mark, or slogan "AMERICA'S FAVORITE PASTA" as defined below, and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.
- c. In the following discovery requests, the term "document" or "documents" is used in its customary broad sense to mean all non-identical copies of all documents within the scope of Rule 34, Fed. R. Civ. P., including, without limitation, reports and/or summaries of interviews; reports and/or summaries of investigations; opinions or reports of consultants; opinions of counsel; communications of any nature including internal company communications; memoranda; notes; letters; e-mail; agreements; reports or summaries of negotiations; brochures; pamphlets; advertisements; circulars; trade letters; press releases; drafts of documents and revisions of drafts of document and any written, printed, typed or other graphic matter of any kind of nature; drawings; photographs; charts; electronically stored data; and all mechanical and electronic sound recordings or transcripts thereof, in the possession and/or control of Opposer or its employees or agents, or known to Opposer to exist, and shall include all non-identical copies of documents by whatever means made and whether or not claimed to be privileged or otherwise excludable from discovery. By way of illustration only and not by way of limitation, any

documents bearing on any sheet or side thereof any marks, including, but not limited to, initials, stamped indicia, comment or notation of any character and not a part of the original text or any reproduction thereof, is to be considered a separate document. In the case of a machine readable document, identify the specifications and/or common name of the machine on which the document can be read such as "VHS videotape, MS DOS (IBM) PC using WordPerfect 5.1" or the like.

d. In the following discovery requests, where identification of a document is required, such identification should describe the document sufficiently so that it can be specifically requested under Rule 34 of the Federal Rules of Civil Procedure and should include without limitation the following information, namely:

- i. the name and address of the author;
- ii. the date;
- iii. the general nature of the document, i.e., whether it is a letter, memorandum, pamphlet, report, advertising (including proofs), etc.;
- iv. the general subject matter of the documents;
- v. the name and address of all recipients of copies of the documents;
- vi. the name and address of the person now having possession of the original and the location of the original;
- vii. the name and address of each person now having possession of a copy of and the location of each such copy;

viii. for each document Opposer contends is privileged or otherwise excludable from discovery, the basis or such claim of privilege or other grounds for exclusion; and

ix. whether Opposer is willing to produce such document voluntarily to Barilla for inspection and copying.

e. In the following discovery requests, where identification of a person, as defined, is required, state:

i. the person's full name, state of incorporation, if any, present and/or last known home address (designating which), present and/or last known position or business affiliation (designating which) and/or present or last known (designating which) affiliation with Opposer, if any. In the case of a present or past employee, officer or director or agent of Opposer, also state the person's period of employment or affiliation with Opposer, and his or her present or last position during his affiliation with Opposer.

f. In the following discovery requests, where identification of an oral communication is required, state the date, the communicator, the recipient of the communication, and the nature of the communication.

g. All references in these discovery requests to Opposer's Mark means the term, mark or slogan "AMERICA'S FAVORITE PASTA", *per se*, as shown in Application Serial No. 76/497,489, and all variations thereof, whether printed in all capital letters, all lower case letters, or a mixture of capital and lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, numbers, symbols, or designs, including, but not limited to, an American Flag.

h. Whenever used herein, the term "&" shall be deemed to include the term "and" and the term "n"; the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to include each of the other functional words.

i. The terms "state" or "describe" (as used with respect to the specific interrogatories below) shall mean to set forth and/or identify with particularity all evidence or other information available to Opposer concerning the matter, to identify each person with knowledge and to identify all communications and documents concerning the subject matter.

INTERROGATORIES

Interrogatory No. 1.

Identify the officer(s) or employee(s) of AIPC primarily responsible for the sales and marketing of goods under Opposer's Mark.

Interrogatory No. 2.

Identify and describe each pasta item ever sold by IPC or on its behalf under Opposer's Mark.

Interrogatory No. 3.

State the exact date on which Opposer will rely as the first date of use of Opposer's Mark in connection with the sale of each pasta item specified in Response to Interrogatory No. 2.

Interrogatory No. 4.

Identify all documents, purchase orders, invoices, labels or any writing whatsoever which Opposer will rely upon to establish the date specified in response to Interrogatory No. 3.

Interrogatory No. 5.

State the exact date on which Opposer will rely as the first date of use of the term AMERICA'S FAVORITE in connection with the sale of each pasta item specified in Response to Interrogatory No. 2.

Interrogatory No. 6.

Identify all documents, purchase orders, invoices, labels or any writing whatsoever which Opposer will rely upon to establish the date specified in response to Interrogatory No. 5.

Interrogatory No. 7.

With respect to each pasta item identified in response to Interrogatory No. 2, state:

- (a) The manner in which Opposer's Mark is used, *e.g.*, by affixation to packaging, on labels, etc.;

- (b) Whether AIPC itself ever manufactured the pasta item and, if not, the identity of the manufacturer;
- (c) Whether the sale of the pasta item has been continuous from January 1, 1997 through present;
- (d) If the answer to subparagraph (c) is in the negative, state the periods of time for which Opposer's Mark was not used.

Interrogatory No. 8.

List all geographical areas (by city and/or state) in which each pasta item specified in response to Interrogatory No. 2 is distributed and/or sold under Opposer's Mark.

Interrogatory No. 9.

Identify all media which AIPC or its licensee has utilized to advertise or promote each pasta item specified in response to Interrogatory No. 2.

Interrogatory No. 10.

For each calendar year since 1997 state the amount expended by Opposer in connection with the advertising or promotion in the U.S. of each pasta item specified in response to Interrogatory No. 2 and sold under Opposer's Mark.

Interrogatory No. 11.

For each calendar year since 1997, state the amount of sales (by dollar or volume), by Opposer or its licensee, of each item of pasta specified in response to Interrogatory No. 2, or item bearing Opposer's Mark.

Interrogatory No. 12.

Identify by name and address all persons, organizations or agencies responsible for advertising each pasta item specified in response to Interrogatory No. 2 bearing Opposer's Mark.

Interrogatory No. 13.

State all facts that support the claim that the Mueller's Brand is "AMERICA'S FAVORITE PASTA" and identify any documents sufficient to support such facts.

Interrogatory No. 14.

State all facts that support your allegation that Barilla filed its application for the mark BARILLA - AMERICA'S FAVORITE PASTA "with notice and knowledge of the prior rights and use of Opposer's AMERICA'S FAVORITE PASTA Marks in connection with pasta products" and identify any documents sufficient to support such facts.

Interrogatory No. 15.

State the earliest date that Opposer was aware of Barilla's intent-to-use BARILLA - AMERICA'S FAVORITE PASTA in connection with pasta products.

Interrogatory No. 16.

Identify all persons who participated in any way in the preparation of the answers or responses to these Interrogatories and state specifically, with reference to Interrogatory numbers, the area of participation of each such person.

Respectfully submitted,

BARILLA G.E.R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron

G. Franklin Rothwell

Robert H. Cameron

ROTHWELL, FIGG, ERNST & MANBECK P.C.

1425 K Street, NW, Suite 800

Washington, DC 20005

Telephone: (202) 783-6040

Facsimile: (202) 783-6031

Dated: September 9, 2004

CERTIFICATE OF SERVICE

I hereby certify that on the 9th day of September, 2004, I served the foregoing
APPLICANT'S FIRST SET OF INTERROGATORIES by causing a true copy thereof to be sent,
in the manner indicated, to the following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108



Robert DiGiovanni

interrog1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA)	
COMPANY,)	
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v.)	Opposition No. 91-161,373
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BARILLA G. E R. FRATELLI - SOCIETA)	
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Applicant.)	

APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS

Pursuant to Rule 36 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice in Trademark cases, Applicant, Barilla G.E R. Fratelli - Societa Per Azioni ("Barilla"), propounds the following requests for admission to Opposer, American Italian Pasta Company ("AIPC") for which responses are to be served on Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Robert H. Cameron, Esq., within thirty (30) days of the service hereof.

For purposes of these Requests, the following Definitions and Instructions are set forth below.

For the convenience of the parties and the Board, each Request for Admission should be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

- a. The word "person" or "entity" shall mean and include without limitation, individuals, firms, associations, partnerships, and corporations.
- b. The term "Opposer", "AIPC", "you" or "your" shall mean American Italian Pasta Company, its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of the term, mark, or slogan "AMERICA'S FAVORITE PASTA" as defined below, and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.
- c. All references in these requests for admission to Opposer's Mark means the term, mark or slogan "AMERICA'S FAVORITE PASTA" *per se*, as shown in Application Serial No. 76/497,489 and all variations thereof, whether printed in all capital letters, all lower case letters, or a mixture of capital and lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, numbers, symbols or designs, including, but not limited to an American flag.
- d. Whenever used herein, the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to include the disjunctive ("or"); and each of the functional words "each," "every," "any," and "all" shall be deemed to include each of the other functional words.

REQUESTS

Request No. 1:

One definition of the term FAVORITE is "liked or preferred above all others" (quoted from *Webster's II New College Dictionary* (Houghton Mifflin 2001)).

Request No. 2:

Opposer's Mark has never been used by AIPC on packaging or advertising where the word MUELLER'S does not also appear in prominent type.

Request No. 3:

AIPC does not and has not ever promoted Opposer's Mark without reference to the MUELLER's brand of pasta products.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron

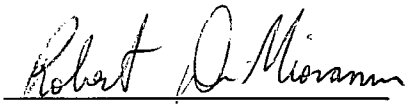
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Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Robert DiGiovanni

admissionreq1

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BARILLA G. E R. FRATELLI- SOCIETA)	
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**APPLICANT'S FIRST SET OF REQUESTS FOR THE
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice in Trademark cases under 37 CFR §2.116, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests Opposer, American Italian Pasta Company ("AIPC"), to produce for inspection and copying the documents designated below at the offices of Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Robert H. Cameron, Esq., within thirty (30) days of the service hereof or at such other time and place as the parties agree.

Definitions and Instructions

A. The Definitions and Instructions in Applicant's First Set of Interrogatories are incorporated herein by reference.

B. If Opposer knows of the existence, past or present, of any document or thing requested herein, but is unable to produce such document or thing because it is not presently in

the possession, custody or control of Opposer, AIPC is requested to identify such document or thing in the same manner set forth in paragraph C hereof.

C. In the event that Opposer contends that any document or thing requested is privileged or otherwise excluded from discovery, Opposer is requested to specify the basis of the privilege or other grounds for exclusion and to identify the document or thing by stating the date, time, title, author and recipient of the document or thing; the type of document or thing; and the present or last known custodian of the document or thing.

D. The following requests are deemed to be continuing pursuant to Fed.R.Civ.P. 26(e) so that with respect to any request herein, or part thereof, as to which Opposer, after responding, discovers additional responsive documents or things, Barilla requests that Opposer produce such documents or things within thirty (30) days after acquiring knowledge of their existence, or advise Barilla in writing as to why such additional documents or things cannot be produced within the specified period.

E. Each document or thing should be labeled or otherwise produced in such a way that the file in which the document or thing is maintained in the normal course of Opposer's business can be easily determined. Alternatively, the documents or things produced shall be organized and labeled to correspond to the category specified in the requests as required by Fed.R.Civ.P. 34.

F. Documents which are bound or fastened together shall be bound or fastened together in that same fashion at the time of production.

REQUESTS

Request No. 1:

All documents requested to be identified in Barilla's First Set of Interrogatories to Opposer.

Request No. 2:

Representative samples of all advertisements, press releases, brochures, price lists, catalogs, newspapers, magazine and trade articles, and other promotional materials containing or bearing each form of Opposer's Mark for use or intended use.

Request No. 3:

For each year since 1997, representative samples of each form of affixation or association of Opposer's Mark to or with the pasta items identified in AIPC's Answer to Interrogatory No. 2 of Barilla's First Set of Interrogatories (*e.g.*, samples of each and every type of label, package, product or tag which bears each form of Opposer's Mark).

Request No. 4:

All licenses, agreements, contracts, assignments or consents to use naming AIPC or any predecessor-in-interest, including but not limited to BEST FOODS and/or UNILEVER as a party and relating to the use of AMERICA'S FAVORITE PASTA in connection with any pasta items specified in response to Interrogatory No. 2 of Barilla's First Set of Interrogatories.

Request No. 5:

All documents received from third parties, including any state or federal agencies, concerning AIPC's use of Opposer's Mark on its packaging of pasta products.

Request No. 6:

All documents concerning Opposer's awareness of Barilla, Barrila's trademark application for BARILLA - AMERICA'S FAVORITE PASTA, or any pasta products provided by Barilla in the U.S.

Request No. 7:

All documents concerning or showing confusion in the U.S., including, without limitation, misdirected mail, records of misdirected telephone calls or inquiries, between Barilla's Mark BARILLA - AMERICA'S FAVORITE PASTA and Opposer's Mark or confusion in the U.S. between goods manufactured, sold or distributed by Barilla bearing any designation BARILLA - AMERICA'S FAVORITE PASTA and goods manufactured, sold or distributed by Opposer or confusion in the U.S. as to the source of the parties' goods.

Request No. 8:

All documents and things that reflect, evidence, or concern the degree of public recognition of Opposer's Mark in the U.S., including but not limited to market research, polls, or surveys conducted by or caused to be conducted or obtained by Opposer.

Request No. 9:

All documents which relate to: (a) the meaning or significance of Opposer's Mark; or (b) consumers' awareness or understanding of Opposer's Mark.

Request No. 10:

All documents referring or relating to any actual or threatened proceedings (e.g., lawsuits, oppositions, cancellations, etc.) involving a mark consisting in whole or in part of the words "AMERICA'S FAVORITE PASTA" in which Opposer has ever been involved, which

concerns allegations of trademark, service mark, trade name or trade dress infringement or unfair competition based on improper use of a trademark, service mark, trade name, trade dress or any other source identifier.

Request No. 11:

All documents referring or relating to any and all searches or investigations (*e.g.*, on a federal, state or common law basis) which have been conducted concerning Opposer's Mark, including documents referring or relating to any such searches or investigations concerning all marks ever considered by Opposer as possible alternatives to Opposer's Mark.

Request No. 12:

All documents referring or relating to Opposer's consideration, selection and/or adoption of Opposer's Mark, including documents referring or relating to any alternatives to said mark considered by Opposer.

Request No. 13:

All documents referring or relating to Opposer's decision to apply to register Opposer's Mark with the U.S. Patent and Trademark Office.

Request No. 14:

Each business, marketing, advertising or media plan prepared by or on behalf of AIPC which refers or relates in any way to Opposer's Mark.

Request No. 15:

All documents evidencing AIPC's knowledge of third party marks having the designation "AMERICA'S FAVORITE" in whole or in part for any food products.

Request No. 16:

Those documents which support, rebut or otherwise relate to AIPC's claim that any pasta products it sells or sold in the U.S. are literally "AMERICA'S FAVORITE PASTA."

Request No. 17:

All documents and things which reflect, refer to, relate to or evidence a discontinued or interrupted use of Opposer's Mark by AIPC, after its first use, for any of the pasta items specified in Response to Interrogatory No. 2 of Barilla's First Set of Interrogatories.

Request No. 18:

All documents and things which reflect, refer to, relate to or concern any advertising or public relation firm activity, including correspondence, for AIPC's goods sold under Opposer's Mark from 2000 through present.

Request No. 19:

All documents referring or relating to or evidencing any standards or guidelines to be followed by you or any other entity for use of Opposer's Mark on packaging of pasta products.

Request No. 20

All documents showing use of any kind by any third party of the phrases "America's
Favorite Pasta."

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron

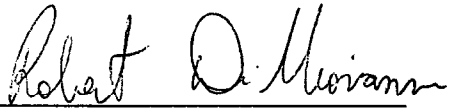
G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
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Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Dated: September 9, 2004

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Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108



Robert DiGiovanni

docreq1

EXHIBIT
B

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APPLICANT'S SECOND SET OF INTERROGATORIES

Pursuant to Rules 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests that Opposer, American Italian Pasta Company ("AIPC"), serve upon Applicant sworn answers to the interrogatories set forth below at the offices of Rothwell, Figg, Ernst & Manbeck, 1425 K Street, N.W., Suite 800, Washington, D.C. 20005, within thirty (30) days after the service hereof. These discovery requests are intended to be continuing in nature and any information or related materials which may be discovered subsequent to the service and filing of the answers should be brought to the attention of the Applicant through supplemental answers within a reasonable time following such discovery.

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DEFINITIONS AND INSTRUCTIONS

- a. The word "person" or "entity" shall mean and include without limitation, individuals, firms, associations, partnerships, and corporations.
- b. The term "Opposer", "AIPC," "you" or "your" shall mean American Italian Pasta Company, its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of the term, mark, or slogan "AMERICA'S FAVORITE PASTA" as defined below, and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.
- c. In the following discovery requests, the term "document" or "documents" is used in its customary broad sense to mean all non-identical copies of all documents within the scope of Rule 34, Fed. R. Civ. P., including, without limitation, reports and/or summaries of interviews; reports and/or summaries of investigations; opinions or reports of consultants; opinions of counsel; communications of any nature including internal company communications; memoranda; notes; letters; e-mail; agreements; reports or summaries of negotiations; brochures; pamphlets; advertisements; circulars; trade letters; press releases; drafts of documents and revisions of drafts of document and any written, printed, typed or other graphic matter of any kind of nature; drawings; photographs; charts; electronically stored data; and all mechanical and electronic sound recordings or transcripts thereof, in the possession and/or control of Opposer or its employees or agents, or known to Opposer to exist, and shall include all non-identical copies of documents by whatever means made and whether or not claimed to be privileged or otherwise excludable from discovery. By way of illustration only and not by way of limitation, any

documents bearing on any sheet or side thereof any marks, including, but not limited to, initials, stamped indicia, comment or notation of any character and not a part of the original text or any reproduction thereof, is to be considered a separate document. In the case of a machine readable document, identify the specifications and/or common name of the machine on which the document can be read such as "VHS videotape, MS DOS (IBM) PC using WordPerfect 5.1" or the like.

d. In the following discovery requests, where identification of a document is required, such identification should describe the document sufficiently so that it can be specifically requested under Rule 34 of the Federal Rules of Civil Procedure and should include without limitation the following information, namely:

- i. the name and address of the author;
- ii. the date;
- iii. the general nature of the document, i.e., whether it is a letter, memorandum, pamphlet, report, advertising (including proofs), etc.;
- iv. the general subject matter of the documents;
- v. the name and address of all recipients of copies of the documents;
- vi. the name and address of the person now having possession of the original and the location of the original;
- vii. the name and address of each person now having possession of a copy of and the location of each such copy;

viii. for each document Opposer contends is privileged or otherwise excludable from discovery, the basis or such claim of privilege or other grounds for exclusion; and

ix. whether Opposer is willing to produce such document voluntarily to Barilla for inspection and copying.

e. In the following discovery requests, where identification of a person, as defined, is required, state:

i. the person's full name, state of incorporation, if any, present and/or last known home address (designating which), present and/or last known position or business affiliation (designating which) and/or present or last known (designating which) affiliation with Opposer, if any. In the case of a present or past employee, officer or director or agent of Opposer, also state the person's period of employment or affiliation with Opposer, and his or her present or last position during his affiliation with Opposer.

f. In the following discovery requests, where identification of an oral communication is required, state the date, the communicator, the recipient of the communication, and the nature of the communication.

g. All references in these discovery requests to Opposer's Mark means the term, mark or slogan "AMERICA'S FAVORITE PASTA", *per se*, as shown in Application Serial No. 76/497,489, and all variations thereof, whether printed in all capital letters, all lower case letters, or a mixture of capital and lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, numbers, symbols, or designs, including, but not limited to, an American Flag.

h. Whenever used herein, the term "&" shall be deemed to include the term "and" and the term "n"; the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to include each of the other functional words.

i. The terms "state" or "describe" (as used with respect to the specific interrogatories below) shall mean to set forth and/or identify with particularity all evidence or other information available to Opposer concerning the matter, to identify each person with knowledge and to identify all communications and documents concerning the subject matter.

INTERROGATORIES

Interrogatory No. 17:

State the ordinary meaning of the word "favorite".

Interrogatory No. 18:

State the meaning of the word "favorite" in the context of Opposer's Mark.

Interrogatory No. 19:

With respect to any of Opposer's answers to Applicant's First and Second Set of Requests for Admission that were anything other than an unqualified admission, state in detail all facts and identify all documents and materials that support the answer.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron

G. Franklin Rothwell

Robert H. Cameron

ROTHWELL, FIGG, ERNST & MANBECK P.C.

1425 K Street, NW, Suite 800

Washington, DC 20005

Telephone: (202) 783-6040

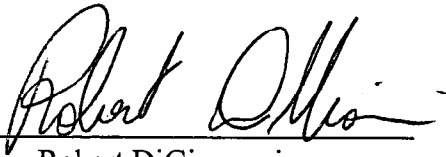
Facsimile: (202) 783-6031

Dated: February 22, 2005

CERTIFICATE OF SERVICE

I hereby certify that on the 22nd day of February, 2005, I served the foregoing by causing a true copy thereof to be sent, in the manner indicated, **APPLICANT'S SECOND SET OF INTERROGATORIES**, to the following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Robert DiGiovanni

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA
COMPANY,

Opposer

v.

BARILLA G. E R. FRATELLI - SOCIETA
PER AZIONI

Applicant.

Opposition No. 91-161,373

APPLICANT'S SECOND SET OF REQUESTS FOR ADMISSION

Pursuant to Rule 36 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice in Trademark cases, Applicant, Barilla G.E R. Fratelli - Societa Per Azioni ("Barilla"), propounds the following requests for admission to Opposer, American Italian Pasta Company ("AIPC") for which responses are to be served on Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Robert H. Cameron, Esq., within thirty (30) days of the service hereof.

For purposes of these Requests, the following Definitions and Instructions are set forth below.

For the convenience of the parties and the Board, each Request for Admission should be quoted in full immediately preceding the response.

DEFINITIONS AND INSTRUCTIONS

- a. The word "person" or "entity" shall mean and include without limitation, individuals, firms, associations, partnerships, and corporations.
- b. The term "Opposer", "AIPC", "you" or "your" shall mean American Italian Pasta Company, its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of the term, mark, or slogan "AMERICA'S FAVORITE PASTA" as defined below, and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.
- c. All references in these requests for admission to Opposer's Mark means the term, mark or slogan "AMERICA'S FAVORITE PASTA" *per se*, as shown in Application Serial No. 76/497,489 and all variations thereof, whether printed in all capital letters, all lower case letters, or a mixture of capital and lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, numbers, symbols or designs, including, but not limited to an American flag.
- d. Whenever used herein, the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to include the disjunctive ("or"); and each of the functional words "each," "every," "any," and "all" shall be deemed to include each of the other functional words.

REQUESTS

Request No. 4:

The slogan AMERICA'S FAVORITE PASTA informs the public that pasta products sold under Opposer's Mark are made in the United States as opposed to Italy or other countries.

Request No. 5:

The slogan AMERICA'S FAVORITE PASTA informs the public that pasta products sold under Opposer's Mark have been enjoyed by U.S. consumers for many years.

Request No. 6:

Opposer has been aware since at least as early as 2001 that Applicant's dry pasta products sold under the trademark BARILLA enjoy a greater percentage share of total U.S. retail sales than dry pasta products sold under Opposer's Mark.

Request No. 7:

Attached hereto at Tab A is a true and correct copy of an Affidavit executed by AIPC's President and Chief Executive Officer dated November 13, 2002 and filed with the U.S. District Court for the Western District of Missouri in 2002.

Request No. 8:

Attached at Exhibit "E" to the Affidavit at Tab A is a true and correct copy of packaging authorized and/or utilized by AIPC for dry pasta products sold under Opposer's Mark since at least as early as 2002.

Request No. 9:

AIPC does not make any claim in the advertising, packaging or promotion of its products that the Mueller's Brand is the Number #1 selling brand of dried pasta.

Request No. 10:

The representation in the Affidavit at Tab A that U.S. consumers associate the Mueller's Brand with American as opposed to Italian pasta products is true and accurate.

Request No. 11:

The representation in the Affidavit at Tab A that "Mueller's is perceived as the quintessential, all-American brand for dried pasta" is true and accurate.

Request No. 12:

The public association of the Mueller's Brand with the facts attested to in the Affidavit at Tab A, Paragraph 13 are true and accurate.

Request No. 13:

The statement quoted in the Affidavit at Tab A, Paragraph 17 is still in use on packaging of AIPC's pasta products sold under Opposer's Mark.

Request No. 14:

Since at least as early as 2002, Opposer has used the slogan AMERICA'S FAVORITE PASTA together with a "flag" design to reinforce that pasta products sold under Opposer's Mark are manufactured in the U.S.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

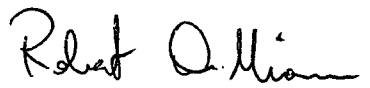
By: Robert H. Cameron
G. Franklin Rothwell
Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Dated: February 22 2005

CERTIFICATE OF SERVICE

I hereby certify that on the 22nd day of February, 2005, I served the foregoing APPLICANT'S
SECOND SET OF REQUESTS FOR ADMISSIONS by causing a true copy thereof to be sent,
in the manner indicated, to the following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108



Robert DiGiovanni

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA)	
COMPANY,)	
)	
Opposer)	
)	
v.)	Opposition No. 91-161,373
)	
BARILLA G. E R. FRATELLI- SOCIETA)	
PER AZIONI,)	
)	
Applicant.)	

**APPLICANT'S SECOND SET OF REQUESTS FOR THE
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice in Trademark cases under 37 CFR §2.116, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests Opposer, American Italian Pasta Company ("AIPC"), to produce for inspection and copying the documents designated below at the offices of Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Robert H. Cameron, Esq., within thirty (30) days of the service hereof or at such other time and place as the parties agree.

Definitions and Instructions

The Definitions and Instructions in Applicant's First Set of Interrogatories and Requests for Production of Documents and Things are incorporated herein by reference.

REQUESTS

Request No. 21:

All documents requested to be identified in Barilla's Second Set of Interrogatories to Opposer.

Request No. 22:

All documents identified or relied upon in the Affidavit of Timothy S. Webster attached to Barilla's Second Set of Requests for Admission at Tab A.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: Robert H. Cameron

G. Franklin Rothwell

Robert H. Cameron

ROTHWELL, FIGG, ERNST & MANBECK P.C.

1425 K Street, NW, Suite 800

Washington, DC 20005

Telephone: (202) 783-6040

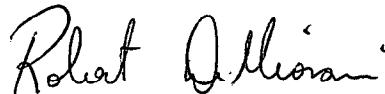
Facsimile: (202) 783-6031

Dated: February 22, 2005

CERTIFICATE OF SERVICE

I hereby certify that on the 22nd day of February, 2005, I served the foregoing
APPLICANT'S SECOND SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS
AND THINGS by causing a true copy thereof to be sent, in the manner indicated, to the
following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108

A handwritten signature in cursive script, reading "Robert DiGiovanni", written in black ink.

Robert DiGiovanni

EXHIBIT
C

LAW OFFICES
HOVEY WILLIAMS LLP
A LIMITED LIABILITY PARTNERSHIP OF PROFESSIONAL CORPORATIONS
ESTABLISHED 1929

INTELLECTUAL PROPERTY LAW
U.S. & FOREIGN PATENTS, TRADEMARKS, COPYRIGHTS
& UNFAIR COMPETITION CAUSES

Cheryl L. Burbach
clb@hoveywilliams.com
816.474.9050 ext. 383

April 1, 2005

Mr. Robert H. Cameron
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K Street, NW, Suite 800
Washington, D.C. 20005

Re: *American Italian Pasta Company v. Barilla G. E. R. Fratelli-Societa Per Azioni*
Opposition No. 91-161,373

Dear Robert:

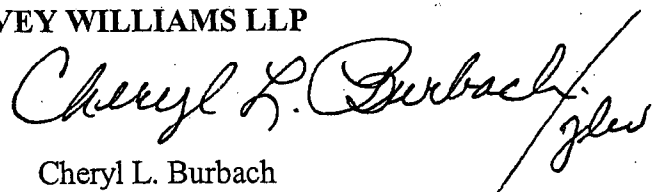
Enclosed are five video tapes and two CD ROMs containing documents we are producing in response to your First and Second Requests for Production of Documents.

Sincerely,

HOVEY WILLIAMS LLP

By

Cheryl L. Burbach

A handwritten signature in cursive script, reading "Cheryl L. Burbach", followed by a diagonal line and the initials "jlew".

CLB:jlw

Enclosures

cc: Mr. Drew Lericos (w/o enclosures)
Thomas H. Van Hoozer (w/o enclosures)

EXHIBIT
D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

American Italian Pasta Company)	
)	
Opposer,)	
)	
v.)	
)	OPPOSITION NO. 91161373
Barilla G. E R. Fratelli)	
- Società Per Azioni)	
(By change of name),)	
)	
Applicant.)	

STIPULATED MOTION FOR EXTENSION OF TIME OF SCHEDULING ORDER

Applicant, Barilla G. E R. Fratelli - Società Per Azioni, with consent of Opposer, respectfully requests the Board for a thirty day extension for discovery to close, and that the testimony periods be reset as appropriate in the above-captioned proceeding.

This request is not being filed for purposes of delay, but to allow the parties additional time to complete exchange of written discovery responses and investigate the related facts.

Counsel for Opposer Thomas H. Van Hoozer, agreed to this extension in a telephone conversation with undersigned counsel on May 6, 2005.

The scheduling order is requested to be reset as follows:

v.

Barilla G. E R. Fratelli
- Società Per Azioni
Opp. 91161373
Page 2 of 2

Discovery period to close

June 7, 2005

Testimony period for party
in position of plaintiff to
close (opening 30 days prior
thereto)

September 5, 2005

Testimony period for party
in position of defendant to
close (opening 30 days prior
thereto)

November 4, 2005

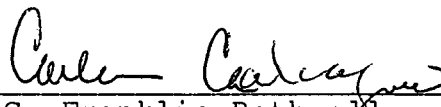
Rebuttal testimony period to
close (opening 15 days prior
thereto)

December 19, 2005

Respectfully submitted,

Barilla G. E R. Fratelli -
Società Per Azioni

By



G. Franklin Rothwell
Carla C. Calcagno
Attorneys for Applicant
ROTHWELL, FIGG, ERNST & MANBECK
1425 K Street, N.W.
Suite 800
Washington, D.C. 20005
Telephone: (202) 783-6040

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **STIPULATED MOTION FOR EXTENSION OF TIME OF SCHEDULING ORDER** was served via first-class mail, in a postage prepaid envelope, on counsel for Opposer as follows:

Thomas H. Van Hoozer, Esq.
Law Offices of Hovey Williams LLP
2405 Grand Boulevard
Suite 400
Kansas City, Mo. 64108-2519

This 9th day of May, 2005.

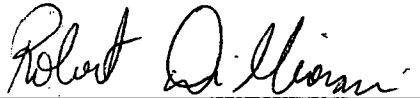

Robert DiGiovanni

EXHIBIT
E

COPY TO CCC

LAW OFFICES

HOVEY WILLIAMS LLP

RECEIVED/DOCKETING

ROTHWELL FIGG ERNST & MANBECK

FILE NO.:

2728-0157

OKT PROG. INT.

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INTELLECTUAL PROPERTY LAW

U.S. & FOREIGN PATENTS, TRADEMARKS, COPYRIGHTS
& UNFAIR COMPETITION CAUSES

JUN - 7 2005

OKT ENTRY INT.

SEND TO:

GFR/CCC/RPD

OK TO FILE

Thomas H. Van Hoozer
tvh@hoveywilliams.com

June 4, 2005

Ms. Carla Calcagno
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, NW, Suite 800
Washington, D.C. 20005

RE: American Italian Pasta Company v. Barilla G.E.R. Fratelli-Societa Per Azioni
Opposition No. 91161373

Dear Carla:

Enclosed please find a CD ROM containing American Italian Pasta production numbers 10881-11284 supplementing our responses to your discovery requests.

Sincerely,

HOVEY WILLIAMS LLP

By


Thomas H. Van Hoozer

TVH:tlm

Encl.

cc: Cheryl Burbach